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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,651	01/14/2004	Achim Kraiss	13906-165001 / 2003P00822	3935
32864	7590	09/07/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			SILVER, DAVID	
			ART UNIT	PAPER NUMBER
			2128	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/757,651		KRAISS, ACHIM	
	Examiner		Art Unit	
	David Silver		2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are pending in Instant Application.

Information Disclosure Statement

2. The information disclosure statement(s) (IDS) submitted on 1/14/04 is/are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement(s) is/are being considered by the examiner if signed and initialed.

Drawings

3. Figure 3 should be designated by legend --Prior Art-- because only that which is old is illustrated (**a computer system**). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Interpretation

4. The mere ability or enablement to perform a function does not necessitate the performance of such function. As such, any prior art not explicitly prohibiting the performance of a function inherently allows for the performance of such function and therefore reads on the limitation. For example, claim 14 recites that the prediction engine is "operable to...". This does not necessitate the actual "operations".

Claim Objections

5. Claims 5 and 6 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 recites "a first set of input values" and "a second set of input values". This inherently means the first set has at least two input values, and the second set of input values.

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Appropriate action is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6.1 As per claims 1-13, the claims do not produce a useful, tangible, and concrete result. The steps of the method claims **do not produce a useful, tangible, and concrete result**. They merely recite a software algorithm, per se, which, for example, does not display, store, or otherwise provide a useful tangible **output**. Note exemplary claim 1 which only recites software steps and does not produce a useful tangible and concrete **result**.

6.2 As per claims 13-21, absent an explicit and deliberate definition in the specification that the product includes an appropriate medium or hardware elements, the claims are directed to software *per se*. Note exemplary claim 13 which recites only software elements. Additionally, software, per se, is not considered concrete under the above-recited MPEP citation (MPEP 2106).

7. The above cited rejections are merely exemplary. The Applicant(s) are respectfully requested to correct all similar errors. Claims not specifically mentioned are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, what is an "application system"?

9. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 21 recites the limitation " the application system". There is insufficient antecedent basis for this limitation in the claim.
11. Claims not specifically mentioned are rejected by virtue of dependency.

Applicants are required to fix all similar occurrences of the above cited deficiencies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-11, and 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Tinsley (**Pub No 2003/0043815 A1**).

Tinsley discloses: 1. A computer-implemented method for providing prediction results to an application system during an interactive session with a user (**Fig 4 step 414 "user can view the content or interact with the content"; Fig 5 step between step 472 and 474 "user responds to any interactive selections"; text which further expands on the figures features**), the method comprising:

receiving a first set of input values from the application system (**para 27; para 9 input ... "takes snapshots of traffic"**);

using a data mining model along with the first set of input values to compute a first prediction result (**para 9 predict ... "correlates the**

traffic and usage data with previously archived data for usage patterns that are used to predict the configuration");

saving state information generated from the computation of the first prediction result (**para 9 the "previously achieved data" is inherently saved**);

receiving a second set of input values from the application system (**para 27; para 9 input ... "periodically takes snapshots of traffic" implies that the data is taken at least twice**); and

using the data mining model along with the state information and the second set of input values to compute a second prediction result (**para 9**).

Tinsley discloses: 2. The computer-implemented method of claim 1, wherein the method comprises:

sending the first prediction result back to the application system (**para 9 application system ... network; para 80**); and

sending the second prediction result back to the application system (**para 9; 80**).

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Tinsley discloses: 3. The computer-implemented method of claim 1, wherein

the second set of input values includes both the first set of input values and an additional set of input values (**para 9; para 80**), and

wherein the method comprises using the data mining model along with the state information and the additional set of input values to compute the second prediction result (**para 80: "In one embodiment, the system logs the user and stores the contextual feedback, applying any relative weights assigned in the Semantic Map, and utilizing the Semantic Relationships table for indirect assignments, an intermediate table should be employed for optimized resolution; the assignment of relative weights is reflected in the active user state information."**).

Tinsley discloses: 4. The computer-implemented method of claim 1, wherein the method comprises receiving the first set of input values from the application system before the second set of input values are available (**the first set of input values are the ones made from the previous prediction, they are therefore inherently received before the second set of input values**).

Tinsley discloses: 5. The computer-implemented method of claim 1, wherein the first set of input values includes at least two input values (**Fig 2, 3, 4, 5, 7, and texts which further expand on their features; para 80**).

Tinsley discloses: 6. The computer-implemented method of claim 1, wherein the second set of input values includes at least two input values (**Fig 2, 3, 4, 5, 7, and texts which further expand on their features; para 80**).

Tinsley discloses: 7. The computer-implemented method of claim 1, wherein the method comprises:

receiving the first set of input values from the application system during an interactive session with a customer (**Fig 4 step 414**); and

receiving the second set of input values from the application system during the interactive session with the customer (**Fig 4 step 414**).

Tinsley discloses: 8. The computer-implemented method of claim 1, wherein the data mining model is a

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decision tree model (**para 73**).

Tinsley discloses: 9. The computer-implemented method of claim 8, wherein the state information includes information about a particular node in the decision tree model.

Tinsley discloses: 10. The computer-implemented method of claim 1, wherein the data mining model is a Naive Bayes model (**para 72**).

Tinsley discloses: 11. The computer-implemented method of claim 10, wherein the state information includes intermediate probability information (**para 72**).

As per claim 13 and 21, note the rejection of claim 1 above. The Instant Claim is functionally equivalent to the above-rejected claim and therefore rejected under same prior-art teachings.

As per claims 14-20, note the rejection of claims 1-2, 4, 8-11 above, respectively. The Instant Claims are functionally equivalent to the above-rejected claims and therefore rejected under same prior-art teachings.

13. Claims 1, 12-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamayo (**US 20020083067 A1**).

Tamayo discloses: 1. A computer-implemented method for providing prediction results to an application system during an interactive session with a user, the method comprising:

receiving a first set of input values from the application system (**para 42**); using a data mining model along with the first set of input values to compute a first prediction result (**para 42**); saving state information generated from the computation of the first prediction result (**para 72**); receiving a second set of input values from the application system (**para 42**); and using the data mining model along with the state information and the second set of input values to compute a second prediction result (**para 72**).

Tamayo discloses: 12. The computer-implemented method of claim 1, wherein the first and second prediction results each specify a probability of customer churn (**para 241**).

As per claims 13-14 and 21, note the rejection of claim 1 above. The Instant Claims are functionally equivalent to the above-rejected claim and therefore rejected under same prior-art teachings.

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Examiner Requests

14. The Examiner respectfully requests, in the event the Applicants choose to amend or add new claims, that such **claims and their limitations be directly mapped to the specification, which provides support for the subject matter**. This will assist in expediting compact prosecution.

Conclusion

15. All claims are rejected.
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- US 20020083067 discloses enterprise web mining system and method
- US 20030088565 discloses method and system for mining large data sets
- US 20040015386 discloses system and method for sequential decision making for customer relationship management
- US 6836773 discloses enterprise web mining system and method
- US 20050102292 discloses enterprise web mining system and method
17. The art was not relied upon in a rejection because it is cumulative to the applied art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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David Silver
Patent Examiner
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8/30/06


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